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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,957	12/16/2003	Alain Duerr	66012-0010	4438

10291 7590 07/06/2005

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EXAMINER

GEHMAN, BRYON P

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/736,957	Applicant(s) DUERR, ALAIN	
	Examiner Bryon P. Gehman	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. This action supersedes the action originally mailed June 7, 2005, which failed to consider the latest submitted claims.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 25-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 25, line 4, "the container walls" lacks antecedent basis.

In claim 27, lines 1-2 and 3, "the container wall" lacks antecedent basis for one such wall.

In claim 28, lines 1-2, "the container" lacks antecedent basis.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11, 14, 18, 20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Dews (4,205,750). Disclosed is a container (13) having a transparent or

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nontransparent container wall and containing a pharmaceutical formulation and a covering (15) which makes the pharmaceutical formulation appear opaque (hidden) is provided on the outside of the container wall so that the appearance of the pharmaceutical formulation is undetectable (hidden).

As to claim 14, the pharmaceutical formulation appears opaque due to the provision of covering 15.

As to claim 18, the covering (15) is detachably or undetachably arranged on the container wall.

As to claim 20, a label (17) is disclosed.

As to claim 22, the covering (15) is nontransparent.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12, 21-23, 25-27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dews. As to claims 12 and 26, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a

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manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

As to claim 21, to color the covering (15) any color would have been an obvious matter of artistic choice, the color not providing any new and unexpected result.

As to claims 22 and 23, to render the transparent covering translucent or milky or cloudy would have been a matter of choice and degree, as transparent or translucent packaging is interchangeable. To employ translucency as opposed to transparency would not provide an unobvious difference.

As to claim 25, to provide plural containers in the manner of Dews would have been obvious in order to provide a greater amount of the contents.

As to claim 27, the pharmaceutical formulation appears opaque due to the provision of covering 15.

As to claim 29, the pharmaceutical formulation is one of the choices recited.

8. Claims 11-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lerner (5,495,944) in view of any one of Chapman (2,810,978), Shank Jr. (3,937,853), Cavanagh et al. (3,955,020), DE 19536416 and WO 01/87722. Lerner discloses a container for pharmaceutical formulations including a covering in the form of a label. Chapman, Shank Jr., Cavanagh et al., DE 19536416 and WO 01/87722 each disclose a container having a transparent or nontransparent container wall and a covering (13; as shown; 2; 5; 30), which makes the pharmaceutical formulation appear opaque (hidden)

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or altered in appearance, provided on the outside of the container wall so that the appearance of the pharmaceutical formulation is undetectable (hidden).

As to claims 13 and 24, Lermer discloses a vial.

As to claims 15-17, all but Chapman of the secondary references disclose a plastic jacket as the covering, detachably or undetachably arranged on the container wall.

As to claim 21, to color the covering (15) any color would have been an obvious matter of artistic choice, the color not providing any new and unexpected result.

As to claims 22 and 23, to render the transparent covering translucent or milky or cloudy would have been a matter of choice and degree, as transparent or translucent packaging is interchangeable. To employ translucency as opposed to transparency would not provide an unobvious difference.

As to claim 25, to provide plural containers in the manner of Lermer would have been obvious in order to provide a greater amount of the contents.

As to claim 27, the pharmaceutical formulation of Lermer appears opaque due to the provision of covering 15.

As to claim 29, the pharmaceutical formulation of Lermer is one of the choices recited.

9. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 11 above, and further in view of Sorensen (2,317,860). To any degree transparency and translucency are not considered obvious variants of

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one another, Sorensen discloses (first page, right column, lines 33-43) transparency and translucency being used interchangeably.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

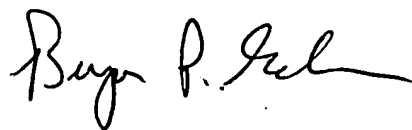
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Bryon P. Gehman". The signature is fluid and cursive, with a long horizontal stroke at the end.

Bryon P. Gehman
Primary Examiner
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BPG